

This rejection is untenable. Jain lacks the following recitation recited in independent claim 1:

"wherein the copy-protection film includes surface segments of different polarization-rotating or filtering properties, wherein the surface segments, viewed together, show an information pattern that contains coded information, at least in part, and that the optically readable information on the information carrier also contains coded information, at least in part, and wherein the coded information of the copy-protection film comprises a decoding key for the coded information of the information carrier, or vice versa."

Thus, independent claim 1 recites that the copy-protection film includes an information pattern that contains coded information and an information carrier that contains coded information "wherein the coded information of the copy-protection film comprises a decoding key for the coded information of the information carrier, or vice versa." With reference to Fig. 6(a) and column 8, beginning at line 56 and continuing to column 9, line 3. Jain's device has an overlay that includes a pattern of information, namely a cutout of "DOT 92". There is no coded information on Jain's base print for which 'DOT 92" is a decoding key. Therefore, Jain lacks the above noted recitation of independent claim 1.

The suggested modification of Jain with Katz's teaching merely results in a card having a holographic image in a portion of the card. There is no teaching to further modify the Jain/Katz combination with a coding in Jain's overlay that comprises a decoding key for coded information on Jain's base print or the Katz overlay. Therefore, the suggested combination also lacks the above noted recitation of independent claim 1.

The Examiner admits that Jain does not disclose or teach an information

carrier with at least one external surface for the readout of optically readable information that contains holographically recorded information. The Examiner alleges that Katz shows that the ability of having holographic images on the surface of "these cards" is well known, citing Katz's abstract and column 1, lines 44 to column 2, line 2. The cited passage, which is from the Background of the Invention section of Katz, describes a credit card that includes a holographic display of an image that is visible to the naked eye in ordinary light. Katz does not disclose in the cited passage or elsewhere a copy protection film that is on the credit card surface. That is, KATZ does not provide a polarization-altering overlay as a copy-protecting film that prevents copying underlying information.

With respect to claim 2, the Examiner contends that "limitation of claim 2 is considered met by the above combination of references, i.e., a 'safety seal'". This contention is traversed. Using the find feature, the text of Jain and the text of Katz in the USPTO database have been searched for "safety seal". There were no hits in either Jain or Katz. Therefore, neither Jain nor Katz nor the combination thereof contains a safety seal as claimed in claim 2. Thus, the rejection of claim 2 is untenable.

The Examiner provides no motivation for one of ordinary skill in the art to provide Jain's information carrier with a hologram as described in Katz. In fact, the suggested combination of Jain and Katz is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerasonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

In particular, one of ordinary skill in the art would have no motivation to combine a hologram from Katz's credit card that has no copy protected film with Jain's information carrier that has a copy protection film.

For the reason set forth above, it is submitted that the rejection of claims 1 and 2 under 35 U.S.C. 103(a) as unpatentable over Jain in view of Katz is untenable and should be withdrawn.

The Office Action rejects claims 3-5 and 9 under 35 U.S.C. 103(a) as unpatentable over the art as applied to claim 1 and further in view of U.S. Patent No. 3,836,754 to Toye et al., hereafter Toye.

This rejection is untenable for the reason set forth in the discussion of claim 1, upon which claims 3-5 and 9 are dependent.

For the reason set forth above, it is submitted that the rejection of claims 3-5 and 9 under 35 U.S.C. 103(a) is untenable and should be withdrawn.

The Office Action rejects claim 6 under 35 U.S.C. 103(a) as unpatentable over the art as applied to claim 1 and further in view of U.S. Patent No. 4,982,073 to Stenzel et al., hereafter Stenzel.

This rejection is untenable for the reason set forth in the discussion of claim 1, upon which claim 6 is dependent.

For the reason set forth above, it is submitted that the rejection of claim 6 under 35 U.S.C. 103(a) is untenable and should be withdrawn.

The Office Action rejects claim 7 under 35 U.S.C. 103(a) as unpatentable over the art as applied to claim 6 and further in view of U.S. Patent No. 4,820,912 to Samyn, hereafter Samyn.

This rejection is untenable for the reason set forth in the discussion of claims 1 and 6, upon which claim 7 is dependent.

For the reason set forth above, it is submitted that the rejection of claim 7 under 35 U.S.C. 103(a) is untenable and should be withdrawn.

The Office Action rejects claim 8 under 35 U.S.C. 103(a) as unpatentable over the art as applied to claim 6 and further in view of U.S. Patent No. 5,111,033 to Fujita, hereafter Fujita.

This rejection is untenable for the reason set forth in the discussion of claims 1 and 6, upon which claim 8 is dependent.

For the reason set forth above, it is submitted that the rejection of claim 8 under 35 U.S.C. 103(a) is untenable and should be withdrawn.

The Office Action rejects claim 10 under 35 U.S.C. 103(a) as unpatentable over the art as applied to claim 1 and further in view of U.S. Patent No. 6,164,548 to Curiel, hereafter Curiel.

This rejection is untenable for the reason set forth in the discussion of claim 1, upon which claim 10 is dependent.

For the reason set forth above, it is submitted that the rejection of claim 10 under 35 U.S.C. 103(a) is untenable and should be withdrawn.

It is respectfully requested for the reasons set forth above that the rejection under 35 U.S.C. 103(a) be withdrawn, that claims 1-10 be allowed and that this application be passed to issue.

Respectfully Submitted,

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